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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,805	09/22/2003	Paul C. Fowler	410724.00003	2166
26707 7590 04/16/2008 QUARLES & BRADY LLP RENAISSANCE ONE TWO NORTH CENTRAL AVENUE PHOENIX, AZ 85004-2391				
EXAMINER				
BROWN, SHEREE N				
ART UNIT		PAPER NUMBER		
2163				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/667,805

Applicant(s)

FOWLER ET AL.

Examiner

SHEREE N. BROWN

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-9 and 11-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9 and 11-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is responsive to Amendments 01/08/2008. Claims 1-2, 5-9, and 11-28 are pending and presented for examination. Claims 3-4, and 10 have been cancelled. Claims 1, 2, 5-6, 8-9, 11, 14, 17-19, 21-22 and 26-27 have been amended.
2. This action has been made FINAL.

Response to Amendment

3. Referring to the 35 USC 112 rejections, applicant's amendments have been withdrawn.
4. Referring to the 35 USC 101 rejection, applicant's amendments/arguments have been acknowledged. However, examiner withdraws will withdraw the 35 USC 101 rejection pertaining to claims 1, 9 and 22 but will maintains the 35 USC 101 rejection pertaining to claim 18. See below rejection for more details.
5. Referring to the claim objections, applicant's amendments have been acknowledged. Accordingly, examiner withdraws the objection.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim(s) 18-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

The dependent claims are rejected for depending upon rejected based claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-2, 5-9, and 11-28 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application 2002/0198755 to Birkner et al (hereafter Birkner).

Claim 1:

Birkner discloses a method of synchronizing data in a multi-user computer network

[(i.e. hot sync) See Paragraph 0048, 0054, 0223], comprising:

- accessing a record from a database for a first user [(i.e. estimator workstation 152) See Figure 1, Item 152];
- accessing the record for a second user while the first user is accessing the record [(i.e. project manager 150) See Figure 1, Item 150];
- requesting a first change to the record by the first user [("change order") See Paragraph 0046, 0200, 0223];
- determining by the network server [See Paragraph 0034-0042 & Figures 1-3 wherein the "change order module 177" resides on the network server – See Figure 3, Item 177] whether the first change to the record is authorized [("If change is accepted ... ") See Paragraph 0129, 0200, 0223];

- if the change is authorized, updating the record [(“update the bid”) See Paragraph 0046, 0200, 0223] with the first change for both the first user and the second user substantially simultaneously [(“update the bid”) See Paragraph 0046, 0200, 0223].

Claim 2:

Birkner discloses wherein the database is stored on a hard disk [See Paragraph 0039 and Figures 1 & 2] operating under control of the network server [See Paragraph 0034-0039 & Figures 1-3 wherein the “change order module 177” resides on the network server – See Figure 3, Item 177].

Claim 5:

Birkner discloses wherein the step of making the first change to the record available to the second user [(“update the bid”) See Paragraph 0046, 0200, 0223] is executed by the network server [See Paragraph 0034-0042 & Figures 1-3 wherein the “change order module 177” resides on the network server – See Figure 3, Item 177].

Claim 6:

Birkner discloses wherein the first user operates a first workstation running application software [(i.e. estimator workstation 152) See Figure 1, Item 152], which utilizes the record [(i.e. files) See Paragraph 0223], and the second user operates a second workstation running application software [(i.e. project manager 150) See Figure 1, Item 150], which utilizes the record [(i.e. files) See Paragraph 0223] at substantially the same time as the application software on the first workstation is utilizing the record [(i.e. project manager 150) See Figure 1, Item 150 & Paragraph 0223].

Claim 7:

Birkner discloses wherein the application software running on the second workstation [(i.e. project manager 150) See Figure 1, Item 150]; executes using the first change to the record [(“update the bid”) See Paragraph 0046, 0200, 0223].

Claim 8:

Birkner discloses the method of claim 1 further including:

- requesting a second change to the record by the second user [(“change order”) See Paragraph 0046, 0200, 0223] to the network server [See Paragraph 0034-0042 & Figures 1-3 wherein the “change order module 177” resides on the network server – See Figure 3, Item 177];
- the network server checking for [See Paragraph 0034-0042 & Figures 1-3 wherein the “change order module 177” resides on the network server – See Figure 3, Item 177] an authorization to make the second change to the record [(“If change is accepted ...”) See Paragraph 0129, 0200, 0223];
- and upon authorization [(“If change is accepted ...”) See Paragraph 0129, 0200, 0223] by the network server [See Paragraph 0034-0042 & Figures 1-3 wherein the “change order module 177” resides on the network server – See Figure 3, Item 177], updating the second change [(“change order”) See Paragraph 0046, 0200, 0223] to the record for both the first user and the second user substantially simultaneously [(“update the bid”) See Paragraph 0046, 0200, 0223].

Claims 9-17:

Claims 9-17 are rejected on the same basis as claims 1-8, respectively.

Claim 18:

Claim 18 is rejected on the same basis as claim 1, respectively.

Claims 19-21:

Claims 19-21 are rejected on the same basis as claims 6-8, respectively.

Claims 22:

A method of utilizing data in a multi-user computer system [(i.e. hot sync) See Paragraph 0048, 0054, 0223], comprising:

- accessing a record from a database to perform a first function on a first network node [(i.e. estimator workstation 152) See Figure 1, Item 152];
- accessing the record to perform a second function on a second network node while the first network node is accessing the record [(i.e. project manager 150) See Figure 1, Item 150];
- processing a first change to the record on the first network node [(“change order”) See Paragraph 0046, 0200, 0223] by the network server [See Paragraph 0034-0042 & Figures 1-3 wherein the “change order module 177” resides on the network server - See Figure 3, Item 177];
- and updating the record according to the first change for both the first network node and the second network node substantially simultaneously [(“update the bid”) See Paragraph 0046, 0200, 0223].

Claims 23-27:

Claims 23-27 are rejected on the same basis as claims 2-6, respectively.

Claim 28:

Birkner discloses wherein the first and second functions involve bidding ["update the bid"

See Paragraph 0046] and estimation on a construction project [See Paragraph 0013, 0017 & 0043].

Response to Arguments

10. Applicant's arguments filed 01/08/2008 have been fully considered but they are not persuasive.

Applicant Argument #1:

Applicant argued on page 9 of 12, "However, the Birkner reference fails to teach several limitations required by claim 1, as amended. For example, the Birkner reference fails to disclose "accessing the record from the database for a second user while the first user is accessing the record." In fact, this element cannot be found anywhere in the Birkner reference".

Examiner Response to Argument #1:

Examiner is not persuaded. MPEP § 2106 states Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed Cir. 1997). Nevertheless, examiner maintains Birkner teaching of "the host system will be *reflected on both* systems after synchronization" meets applicant's claim language and therefore, examiner maintains the rejection.

Applicant Argument #2:

Applicant argued on pages 9-10, "Similarly, the Birkner reference fails to disclose "updating the first change to the record for both the first user and the second user substantially simultaneously".

Examiner Response to Argument #2:

Examiner is not persuaded. MPEP § 2106 states Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed Cir. 1997). Nevertheless, examiner maintains Birkner teaching of “change order” and “update the bid” in paragraph 0046, 0200, and 0223 is the same as applicant’s claim language as mentioned above. Birkner goes on to further teach “the host system will be *reflected on both* systems after synchronization” in which is equivalent to applicant’s claim language of “... *for both the first user and the second user substantially simultaneously*”. Therefore, examiner maintains the rejection.

Applicant Argument #3:

Applicant argued on pages 10-11, “Clearly, an end user dialing up to a network “at the end of each day” as disclosed in Birkner cannot possibly disclose “updating the first change to the record for both the first user and the second user substantially simultaneously.”

Examiner Response to Argument #3:

Examiner is not persuaded. MPEP § 2106 states Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed Cir. 1997). Applicant has only cited “bites and pieces” of Birkner. Birkner correctly states in paragraph 0034-0036, “The data transfer can be performed using this dial up network OR directly from local area networks at the main office. Specifically, the dial up network can simply be the Plain Old

Telephone Service (POTS) network". Birkner goes on to disclose, "the dialup network 120 in turn is connected to a server 130". Nevertheless, paragraph 0223, Birkner states, "during operation, the synchronization software runs in the background mode on the host computer 82 and listens for a synchronization request or command ... changes made on the computer system and the host computer will be reflected on both systems after synchronization ... ".

Examiner maintains Birkner teaching "the host system will be *reflected on both* systems after synchronization" in which is equivalent to applicant's claim language of "... *for both the first user and the second user substantially simultaneously*". Therefore, examiner maintains the rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheree N. Brown whose telephone number is (571) 272-4229. The examiner can normally be reached on Monday-Friday 7:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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April 1, 2008

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